

REMARKS

Upon entry of the present amendment, claims 1-24 are pending in the above-referenced patent application and are currently under examination. Claims 1, 2 and 6-11 have been amended. Support for the amendments can be found throughout the specification. Claim 25 has been canceled. In addition, claims 3-5, 12-21 and 23 have been objected to as being dependent on a rejected base claim. Reconsideration of the application is respectfully requested.

Support for the amendments to the claims can be found in the claims as filed, and throughout the specification. Many of the amendments have been made to correct grammatical errors only.

Applicants thank the Examiner for noting allowable subject matter in claims 3-5, 12-21 and 23, if rewritten in independent form. Applicants also thank the Examiner for the suggestion of agreeable language and for noting grammatical errors.

The claims are rejected in various combinations under 35 U.S.C. § 112, 2d paragraph and 35 U.S.C. § 101. Each of these rejections and objections is addressed below in the order set forth by the Examiner.

I. 35 U.S.C. § 112, 2d PARAGRAPH

Claims 1, 2, 6-11, 22 and 25 have been rejected under 35 USC § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Applicants respectfully traverse the rejection in view of the comments below.

The test for indefiniteness is “whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity” (MPEP § 2173.02). This analysis does not occur in a vacuum, but rather in view of the following factors: (1) the content of the particular application disclosure; (2) the teachings of the prior art; and (3) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. In addition, “the examiner must consider

the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope" (MPEP § 2173.02).

The Examiner suggests amending the phrase "and the solvates, prodrugs and pharmaceutically acceptable salts" in claim 1 to "or a solvate, prodrug or a pharmaceutically acceptable salt." Applicants note that such an amendment has been made to claim 1. Thus, claim 1 is not indefinite under 35 U.S.C. § 112, 2d paragraph. Accordingly, Applicants respectfully request that the Examiner withdraw this aspect of the rejection.

The Examiner has also noted that claims 2 and 6-11 are lacking a period at the end of each claim. Applicants note that claims 2 and 6-11 have been amended to incorporate a period at the end of each claim. Thus, claims 2 and 6-11 are not indefinite under 35 U.S.C. § 112, 2d paragraph. Accordingly, Applicants respectfully request that the Examiner withdraw this aspect of the rejection.

The Examiner has questioned whether the compound of claim 22 is pharmaceutically acceptable. Applicants respectfully note that claim 22 is drawn to a method of treating a bacterial infection in mammals. The specification provides that "mammals" includes "bovines, canines, equines, felines, ovines, porcines, and primates (including humans)" (paragraph [0050], page 19, lines 16-17). Thus, veterinary applications of the method of claim 22 are also envisioned in the instant application. Consequently, Applicants respectfully do not believe that amendment of claim 22 is required, and respectfully submit that claim 22 is not indefinite under 35 U.S.C. § 112, 2d paragraph. Accordingly, Applicants respectfully request that the Examiner withdraw this aspect of the rejection.

The Examiner further alleges that claim 25 is indefinite for merely reciting a use without any active, positive steps delimiting how this use is actually practiced. Applicants note that claim 25 has been canceled. Accordingly, Applicants respectfully note that this aspect of the rejection is now moot.

II. 35 U.S.C. § 101

Claim 25 has been rejected under 35 U.S.C. § 101 as allegedly being an improper process claim. Applicants respectfully note that claim 25 has been canceled. Accordingly, Applicants respectfully note that this aspect of the rejection is now moot.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5015.

Respectfully submitted,



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